

REMARKS

Reconsideration is requested of the Examiner's rejection of claims 1 and 3-21 under 35 U.S.C. 103(a) as being unpatentable over Birenbaum et al. (U.S. Patent No. 4,768,151) in view of Norman et al. (U.S. Patent No. 5,702,305). The Examiner admits that the Birenbaum reference fails to disclose certain features of the claims, and relied on the Norman reference for disclosing a game system comprising a plurality of portable game aids (32) that transmit/receive information blocks between themselves and a first master unit.

The Birenbaum reference teaches a device (10) for managing bingo cards that receives information from a separate and distinct memory module (14). The Birenbaum reference specifically teaches the use of a separate memory module (14) to facilitate the entry of a plurality of bingo cards from any manufacturer by plugging in an appropriate memory module (14). Col. 2, lines 26-28 and 30-32, Col. 3, lines 46-48 and 52-54. Two distinct units are disclosed and are required for the operation of the device of the Birenbaum reference. To play the device (10), data must first be transferred from the memory module (14). Col. 3, lines 44-46.

The Norman reference teaches an electronic game system comprising a plurality of personal display units 14 and a control unit 12. Each personal display unit 14 provides information on each player's game data and the overall game data. The Norman reference essentially replaces a physical game board with an electronic version of a game board such that each player may view his/her game data electronically / virtually through the personal display unit 14. The personal display unit 14 has neither any memory nor any processor of the present invention, but merely a display 68 and a controller 64 in communication with the input device 65. See, col. 7, lines 43-55. The personal display unit 14 is not self-contained and must interact with a separate control unit 12 to play an electronic game. See, Fig. 5.

For a claim to be obvious under 35 U.S.C. 103, each limitation of the claim must be taught or suggested by the prior art reference. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Claim 1 claims a portable programmable apparatus for aiding a player in an interactive manner in the performance of a game of chance comprising:

- (a) a **processor** whose actions are directed by a computer program and having a plurality of ports;
- (b) **a readable memory having prestored blocks of data representative of predetermined numbers and also representative of predetermined patterns** furnished from a media having magnetic coded information which is accessible by means movable relative to said information of said media, wherein said predetermined numbers and patterns are correlated to each other to provide games of chance and are capable of being accessed and manipulated by said processor in response to said computer program;
- (c) **means connected to one of said ports for providing an interactive dialogue between a player using the apparatus and said processor** during the performance of said game of chance, said interactive means allowing the player using the apparatus to enter data associated with said game of chance;
- (d) means connected to one of said ports for providing a display of the stored blocks of data, the data entered by way of said interactive means, and intermediate and final stages of the performance of said game of chance; and
- (e) means for providing a communication protocol for said processor to adapt said processor to communicate with another processor of another portable programmable apparatus.

In considering a prior art reference, it must be considered as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

As discussed above, the Birenbaum reference teaches the loading of data with a separate memory module (14) and requires the use of two distinct units. The Birenbaum reference does not suggest a device with "a readable memory having prestored blocks of data" (element b). In fact, the Birenbaum reference teaches away from prestoring such information in the device (10) by providing a separate memory module (14) that is selected in accordance with a specific set of cards. Col. 3, lines 52-54.

Similarly, the Norman reference does not teach or suggest a device with “a readable memory having prestored blocks of data” since no data representative of predetermined numbers and predetermined patterns are stored or are capable of being stored in the personal display units 14. Instead, the personal display units 14 of the Norman reference display what is communicated to them via the control unit 12. Furthermore, the personal display units 14 of the Norman reference did not disclose a “processor” (element a) nor an “interactive dialogue between a player using the apparatus and said processor” (element c). At most, the personal display units 14 of the Norman reference provide an interaction between a player via his/her personal display unit 14 and the control unit 12, but not directly between the player and the personal display unit 14. This is critical when trying to combine the teachings of these references.

Both the Birenbaum and Norman references teach away from the elements of claim 1 of the present invention and since neither the Birenbaum nor the Norman references, alone or in combination, disclose, teach or suggest each limitation of claim 1, as required under a 35 U.S.C. 103 rejection, claim 1 is not obvious over the Birenbaum reference in view of the Norman reference. Further, since claim 1 is nonobvious under 35 U.S.C. 103, all claims dependent therefrom, including claims 3-12 and 16-17 are similarly nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

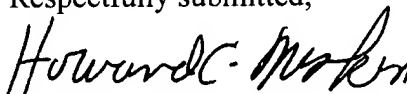
Similar to claim 1, each of the claims 14-15 and 18-21 include the limitations of claim 1 not disclosed, taught or suggested by neither the Birenbaum nor the Norman references, alone or in combination. Therefore, claims 14-15 and 18-21 are similarly nonobvious under 35 U.S.C. 103.

Claim 13 is amended to clarify the invention.

By virtue of the Applicants' amendment, including the arguments for the allowance of the claims, all outstanding grounds of rejections and objections have been addressed and dealt with and, based thereon, it is believed that the application is now in condition for allowance and such action is respectfully requested.

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Respectfully submitted,



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